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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,128	05/28/2002	Andre Martin Van Der Ende	8830-38	8119
23973	7590	06/29/2005		
DRINKER BIDDLE & REATH ATTN: INTELLECTUAL PROPERTY GROUP ONE LOGAN SQUARE 18TH AND CHERRY STREETS PHILADELPHIA, PA 19103-6996			EXAMINER DANG, HUNG Q	
			ART UNIT	PAPER NUMBER
			2635	

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/088,128	<b>Applicant(s)</b> VAN DER ENDE ET AL.	
	<b>Examiner</b> Hung Q. Dang	<b>Art Unit</b> 2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.  
4a) Of the above claim(s) 11-21 and 27-35 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-10 and 22-26 is/are rejected.  
7) ☒ Claim(s) 1,5 and 22 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 5/28/2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/14/2002</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is in response to application's amendment received on 3/24/2005. Applicants elected group I with claims 1-10 and 22-25. Claim 26 has been amended to depend from claim 22.

2. Applicant's election of group I in the reply filed on 3/24/2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Claim Objections***

3. Claims 1 and 22 are objected to because of the following informalities: Claims 1 and 22 contains the terms "capable of". It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Therefore, the claimed limitation of claim 1 "wherein the wireline is capable of acting as an antenna for the transmitter", and the claim limitation of claim 22 "at least one sensor capable of detecting known locations in a wellbore and generating a signal indicative thereof, and a transmission means capable of transmitting the signal" will not be given any patentable weight. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Regarding claim 5, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3-10, 22, 23 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Titchener et al. U.S. Patent 4,828,051.

**Regarding claims 1 and 7**, Titchener et al. teaches a communication system for use in a wellbore, the system comprising a transmitter (Figure 13, unit 352) coupled to a wireline (Figure 1, unit 36), and a receiver (Figure 13, unit 38) located remotely from the transmitter, wherein the wireline is capable of acting as an antenna for the transmitter.

**Regarding claim 3**, the transmitter disclosed by Titchener et al. is indeed associated with an integral part of a tool string.

**Regarding claim 4**, the downhole tool disclosed by Titchener et al. is also suspended by the wireline (See figure 1; wireline 36 and downhole tool 32).

**Regarding claim 5**, the transmitter disclosed by Titchener et al. also transmits data collected or generated by the downhole tool to the receiver (see figure 13).

**Regarding claim 6**, the receiver disclosed by Titchener et al. is also located near the surface of the wellbore (See figure 13, receiver 38 is located near the surface of the wellbore).

**Regarding claim 8**, the wireline disclosed by Titchener et al. is also electrically insulated (column 11, lines 26-33).

**Regarding claim 9**, the wireline disclosed by Titchener et al. is also sheathed to facilitate electrical insulation (column 6, lines 23-34).

**Claims 10, 22 and 23** are rejected for the same reasons as claim 1.

**Regarding claim 26**, the downhole tool disclosed by Titchener et al. is also powered by a DC power supply.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Titchener et al. U.S. Patent 4,828,051 in view of Reinhardt U.S. Patent 6,216,779.

**Regarding claim 2**, Titchener et al. teaches an apparatus as claimed in claim 1. However, Titchener et al. does not specifically teach said wireline is a slickline.

Reinhardt, in the same field of endeavor, teaches a wireline system in a downhole system, which employs a slickline to lower and suspend downhole tools in said downhole (column 5, lines 5-13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a slickline to the system disclosed by Titchener et al., as evidenced by Reinhardt, so that the downhole tools can be lowered and suspended into said wellbore.

10. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Titchener et al. U.S. Patent 4,828,051 in view of Morris et al. U.S. Patent 4,537,286.

**Regarding claims 24 and 25**, Titchener et al. does not teach a rope-socket as a coupling means, however, one skilled in the art would recognize that rope-socket has been commonly used for suspending equipments as evidenced by Morris et al. (column 3, lines 42-65).

Therefore, by conventionality, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a rope-socket to the system disclosed by Titchener et al., as evidenced by Morris et al., in order to suspend said downhole tools.

### Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Q. Dang whose telephone number is (571) 272-3069. The examiner can normally be reached on 9:30AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.D.

MICHAEL HORABIK  
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